

REMARKS/ARGUMENTS

In response to the Office Action of July 15, 2005, reconsideration of the application is respectfully requested.

Claims 24-28, 30-32, 36-40 and 42-44 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Barber et al., U. S. Pat. No. 4,858,121(hereinafter Barber) in view of Little et al., U.S. Pat. No. 5,359,509 (hereinafter Little). Considering first claim 24, there is recited:

“A system comprising:
a point of service terminal . . . which creates a purchase transaction;

an adjudication engine which processes said purchase transaction **substantially in real time** so as to calculate a covered portion of said purchase transaction . . .” (emphasis added)

Neither Barber nor Little disclose the claimed subject matter. As indicated in Barber at column 7, line 30, “When funds have been received from the insurance company” and at column 7, line 51:

“Claims are designated by the physician to be early or prompt payment claims or segregated into a prompt payment fund 270. After a pre-selected number of days, e.g., fourteen, the amounts covered by insurance on the prompt payment claims are organized by physician”

Also at column 8, line 2 “As funds are returned from credit card companies, insurance companies, or patients, the funds are credited to the physician’s accounts” And at column 14, line 51 it is stated “. . . upon receipt of a medical claim at the central processing system B, the medical claims is **held** . . .” (emphasis added)

As stated in Little at column 1, lines 6:

“The present invention relates to a method and apparatus for processing medical health care payment requests received by a

health care insurer or payment processor from a health care provider”

Also as stated in Little at column 6, line 53:

“The payment processor may receive the health care payment request from the health care provider in one of three forms: on paper 211, on magnetic tape 213 or as electronic data through a network 215. The payment processor will **store** the payment request in the payment request database 25” (emphasis added)

In order to establish a *prima facie* case of obviousness, Section 2141 of the MPEP provides:

“there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

None of these requirements is met by the combination of the Barber and Little references. There is no teaching in either of these references of how or why they are to be combined to produce the claimed subject matter. A *prima facie* case of obviousness has not been established. Consequently, reconsideration and allowance of claim 24 is respectfully requested.

Claims 25-28 and 30-32 have also been rejected under 35 U.S.C. 103(a) as unpatentable over Barber in view of Little. These claims are dependent on independent claim 24 and are believed patentable for the same reasons as claim 24.

Claims 36-40 and 42-44 have also been rejected as “have been obvious from, respectively, rejected system claims 24-28 and 30-32 and are therefore rejected using the same art and rationale.” Apparently, this rejection relies on the disclosure of the rejected

system claims which is an improper basis for rejection. As indicated in Section 2141 of the MPEP under “BASIC CONSIDERATION WHICH APPLY TO OBVIOUSNESS REJECTION, item C, . . . The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.” Consequently, reconsideration and withdrawal of the rejection of claims 36-40 and 42-44 on this basis is respectfully requested.

The Office Action does not specifically deal with claim 36 except to reject it as obvious from applicant’s own claims. Therefore, applicant submits that claim 36 is allowable and that claims 37-47 that depend from it are also allowable for the same reasons as claim 36.

Claims 29, 33-35, 41 and 45-47 have been rejected under 35 U.S.C. 103(a) as unpatentable over Little in view of Barber and further in view of Sackler et al. U.S. Pat. No. 5,235,507 (hereinafter Sackler). All of the claims of the application are directed to a system or a method which gives a result in substantially real time. Sackler does not solve the deficiency of the 103 combination of references. All that Sackler discloses is a computerized system for self insurance management. None of Sackler, Barber or Little teach or suggest how the combination is to be made to anticipate these claims. Therefore, a *prima facie* case of obviousness has not been established.

For the above reasons, claims 24-47 are believed allowable and such action is respectfully requested.

It should be understood that the above remarks are not intended to recite an exhaustive basis for patentability or concede the basis for the rejections in the Office

Action, but are simply provided to overcome the rejections made in the Office Action in the most expedient fashion.

In view of the above amendments and remarks, it is respectfully submitted that the present application is in condition for allowance and an early Notice of Allowance is earnestly solicited. If after reviewing this amendment the Examiner feels that any issues remain which must be resolved before the application can be passed to issue, the Examiner is invited to contact the Applicant's undersigned representative by telephone to resolve such issues.

Respectfully submitted,

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